



07-23-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

UNDER 37 CFR 1.10(a)

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G. Patrick Sage

SCHULMAN FTM 48

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Serial No.: 76/137,363
Filing Date: September 28, 2000
Trademark: **INVISION**
Class(es): 1
Applicant: A. SCHULMAN, INC.
Examiner: Brian Brown / Law Office 105

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EX PARTE APPEAL FROM THE EXAMINER OF TRADEMARKS
AFTER FINAL REFUSAL

Applicant hereby appeals to the TRADEMARK TRIAL AND APPEAL BOARD from the decision of the Trademark Examining Attorney refusing registration. This Appeal is taken for all classes listed above, being one (1) class.

Our check in the amount of One Hundred Dollars (\$100.00), representing the Appeal fee, is attached hereto.

Respectfully submitted,

THE FIRM OF HUESCHEN AND SAGE

By: G. Patrick Sage
G. PATRICK SAGE

Dated: July 22, 2002
Customer No.: 25,666
500 Columbia Plaza
350 East Michigan Ave.
Kalamazoo, MI 49007-3856
(616) 382-0030

Enclosure: Postal Card Receipt,
Our check no. 70925 for \$100.00, and
Brief on Appeal, **IN TRIPLICATE ORIGINAL.**

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THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY FURTHER OR ADDITIONAL FEES WHICH MAY BE REQUIRED (DUE TO OMISSION, DEFICIENCY, OR DEFECT IN THE ATTACHED CHECK, OR OTHERWISE), OR TO CREDIT ANY OVERPAYMENT, TO DEPOSIT ACCOUNT NO. 08,3220.

TRADEMARK TRIAL AND
APPEAL BOARD
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BRIEF ON APPEAL UNDER 37 CFR § 2.142

This Brief is submitted in Response to the Final Rejection of January 22, 2002.

ISSUE

Whether the A. SCHULMAN, INC. (hereinafter "Applicant") mark "**INVISION**" for:

"Dry solid plastic materials in bulk powder, pellet, granule and bead form for use in further processing by the plastics manufacturing industry, in International Class 1."

is likely to cause confusion, mistake, or deception with respect to the Dow Chemical Company (hereinafter "Registrant") mark "**ENVISION**" (Registration No. 2,402,908) for:

"Plastic foam laminates for use in vibration dampening, as surface protection and as cushioning material in shipping and packaging, in International Class 17."

Registration of the Applicant's mark is refused under Section 2(d) on two (2) bases. These bases will be rebutted individually.

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First Basis: "THE APPLICANT'S MARK IS HIGHLY SIMILAR IN PRONUNCIATION AND VERBALIZATION TO THE CITED REGISTRATION."

The Applicant submits that likelihood of confusion between marks is determined by an assessment of whether the marks are confusingly similar. The Examiner relies on well established trademark doctrine that a refusal based on the similarity of the marks requires that the marks must be found to possess "...similarities in appearance, sound, connotation and commercial impression", citing In re E.I. DuPont de Nemours & Co., 177 USPQ 563 (CCPA 1973). In rebuttal of the Examiner's conclusion that these requirements are met, the Applicant notes that there are many (153) marks for "ENVISION" in various classes on the record of the USPTO. In addition, it is noted that there are also at least fifteen (15) registered or pending marks for "INVISION", and at least fourteen (14) additional marks that contain the mark "INVISION" on the record of the USPTO. The Applicant submits that, under these circumstances, the cited mark is accorded a narrow scope of protection, certainly NOT extending from Class 17, drawn to finished products into Class 1, drawn to raw materials.

In response, the Examiner does not rebut the Applicant's notation of the numerous ENVISION marks of record in the USPTO. Perhaps this is because registrations are presumed valid until proved otherwise. Rather, the Examiner cites two obscure decisions holding that third party registrations are not relevant to the question of likelihood of confusion. Consideration of the facts of these two old decisions is relevant to the instant inquiry.

Firstly, the Hub Distributing decision does not take notice of cited third party registrations because "...there is considerable turnover due principally to abandonment of commercial interest in the marks subject of the registrations." In re Hub Distributing, Inc., 218 USPQ 284, 286 (TTAB 1983). In the second citation, the applicant was defending against an Opposition by NASA for the use of "APOLLO 8". National Aeronautics and Space Administration v. Record

Chemical Co. Inc., 185 USPQ 563 (1975, TTAB). Clearly, the Opposition Defendant was faced with issues beyond the question of noting third-party registrations. Rather, the decision was based on the fact that the NASA mark "...has achieved an historical significance." National Aeronautics and Space Administration v. Record Chemical Co. Inc., 185 USPQ 563, 567 (1975, TTAB).

The instant circumstance does not conform to the circumstances in the cited decisions. The Examiner does not question the value of the registrations on the record of the USPTO, as one hundred fifty three (153) registrations for "ENVISION" cannot all be subject to "considerable turnover". Similarly, the Examiner does not cite a mark with "historical" significance. The instant refusal is premised on the conclusion that the instant mark sounds confusingly similar to the referenced mark. The fact that there are multiple "INVISION" marks on the record of the USPTO is dispositive of this assertion, especially considering the fact that these copending registrations are presumed valid unless proved otherwise.

Thus, the Applicant asserts that the totality of the circumstances must be considered in the refusal. The similarity of the marks, in relationship to the other marks on the record of the USPTO, as well as their usage in commerce must be assessed. The similarity of the marks is diminished by the undeniable fact that the USPTO has found numerous (153) other "ENVISION" marks to be registrable and not to cause confusion in the marketplace. So much more so, the instant application for "INVISION" must be considered unlikely to confuse, absent evidence to the contrary.

Second Basis: "IT IS PRESUMED THAT THE APPLICATION ENCOMPASSES ALL THE GOODS OF THE TYPE DESCRIBED, INCLUDING THOSE IN THE REGISTRANT'S MORE SPECIFIC IDENTIFICATION, THAT THEY MOVE IN ALL NORMAL CHANNELS OF TRADE, AND THAT THEY ARE AVAILABLE FOR ALL POTENTIAL CUSTOMERS."

The Applicant's mark "INVISION" is used for Class 1 goods, specifically unprocessed plastics, which are then sold to the plastics manufacturing industry; whereas, "ENVISION" in Class 17 is used specifically for plastic foam laminates, a finished product, which is used as cushioning for shipping and dampening vibration. The goods of each mark clearly travel in different channels of trade.

The Examiner concludes that "...it is presumed that the application encompasses all of the goods of the type described, including those in the registrant's more specific identification, that they move in all normal channels of trade and that they are available for all potential customers" (emphasis added). The examiner is not, however, in a position to "presume" such facts. A refusal is not about "presumption" but a reasoned understanding of the facts at hand.

In this regard, the description of goods in the application and the registration are of primary importance. Clearly, foam packing material finished products are not encompassed within the scope of the Applicant's raw materials. The Examiner attempts to support his "presumption" by citing an unrelated registration which, he argues, covers goods which could be grouped into the class of the Applicant's goods and the class of the Registrant's goods. This is, however, of no relevance because this is not instructive or probative of the instant purported likelihood of confusion. The question remains "whether the Applicant's goods are similar and travel in the same channels of trade as those of the cited Registration." The Examiner has presented no evidence that this is the case.

In fact, the specified goods are not so related that the use of purportedly similar marks on the Applicant's and the Registrant's products is likely to cause confusion. In order to justify a refusal for likelihood of confusion, it is necessary that the goods of both the Applicant and the Registrant are so related, or their marketing strategies are such that, they would be likely to be marketed to the same consumers, and that such exposure would, because of the purported similarity in the marks, create the mistaken impression that the goods originate from, or are in

some way associated with, the same producer. In re Manville Corp., 18 USPQ2d 1386 (TTAB 1991).

The Applicant notes that the fact that the goods of the instant application and the registered trademark are "available for all potential customers" is not the standard. In most circumstances all goods are available to all consumers. The question is not one of availability, but rather one of marketing and market.

To this end, the Examining Attorney "presumes" not only that the Applicant's goods encompass those of the Registrant, but also that these goods travel in the same channel of trade. While the Applicant acknowledges that the International Classification system exists for administrative purposes, the Board must give some deference to the fact that the classification system provides structure for distinguishing the subject matter associated with every mark. In this instance, Class 1 goods, specifically unprocessed plastics, which are then sold to the plastics manufacturing industry are, on their face, distinct from the referenced goods of the "ENVISION" registration in Class 17, which goods are described as plastic foam laminates, a finished product, which is used as cushioning for shipping and dampening vibration.

What is more, the Examiner asserts that the respective goods travel in the same channels of trade. In this instance there can be no substitute for evidence of such overlap of commerce. The Applicant has provided, with the now accepted Allegation of Use and attached hereto, marketing materials which specifically associate the goods under the instant application with the provision of raw materials, which materials will be utilized in "...specific application, from arm rests and assist handles to more complex, integrated systems." Clearly, the consumers of raw materials for use in the manufacture of automobile parts, which "...give you the soft, warm, leather-like look and feel that is required for executing good designs..." are not the same consumers who are shopping for "shipping and

packing" materials, which are typically course and very utilitarian in "look" and "feel".

The Examiner cannot, and has not, rebutted the Applicant's actual marketing material by saying that it is conceivable that the goods marketed under the Applicant's mark may encompass the goods of the cited registration. The Applicant solicits the authority of this Board in refusing to accept the Examiner's "presumption" when weighed against the Applicant's legitimate presentation of evidence that the goods marketed under the applied-for trademark will be marketed such that there will not only be no overlap in consumers, but also be no likelihood of confusion.

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In view of the foregoing, it is respectfully submitted that the Examiner has erred, both as to matters of fact and as to matters of law, for which reason reversal of the Examiner and passage of the mark to publication and registration are all respectfully solicited.

AN ORAL HEARING WILL NOT BE REQUESTED.

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INVISION™

SOFT TOUCH SOLUTIONS
FOR AUTOMOTIVE INTERIORS

APPEAL
TO YOUR
SENSES.

SOFTNESS... WITH AN EDGE

Design in the fast lane. The drive towards PVC-free interiors is accelerating. Invision™ soft-touch polyolefins from A. Schulman will keep you on the leading edge. These advanced materials give you the soft, warm, leather-like look and feel that is required for executing good designs.

Shorten your learning curve. Invision™ polyolefins are just the latest of A. Schulman's automotive innovations that date back to the early 1960s. With Invision™, you now have more material options to meet the ever-increasing performance demands for automotive interiors. Our knowledge of part-performance requirements, molding processes and tool design associated with soft-touch applications enables

us to shorten your learning curve with this new material.

When your application requires an innovative approach, we're here to help as part of your team.

Take the curve at top speed. At A. Schulman, we know that speed-to-market is critical. So we provide exactly the right products for your specific application, from arm rests and assist handles to more complex, integrated systems. Invision™ polyolefins have precisely the gloss, mold flow characteristics, colorability, weatherability and other attributes you need, while maintaining the subtle, leather-like feel that the market demands. It's all part of our continuing commitment to be your global, single-source provider of resins and colorants.

Invision™ soft-touch polyolefins — the latest way A. Schulman is fueling your passion for excellence in creating leading-edge automotive interiors.





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